

## REMARKS

This is a response to the Office Action mailed on October 30, 2008. Claims 3, 4, 7, and 8 are presented for examination. Claims 1, 2, 5, and 6 are hereby cancelled without prejudice. Claim 3 has been amended to incorporate the limitations of former claims 5 and 6, and claim 7 has been amended to refer to claim 3. No new matter has been added by these amendments.

### *Claim Rejections Under 35 U.S.C. § 103(a)*

Claims 1-8 were rejected as obvious over an article by Haag, or Haag combined with US7,027,697 (Tatarka) or US6,101,304 (Quistorff). Applicants respectfully disagree.

A finding of obviousness requires that “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103(a). In *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007), the Supreme Court stated that the following factors set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) still control an obviousness inquiry: (1) the scope and content of the prior art; (2) the differences between the prior art and the claimed invention; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness. *KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1388 quoting *Graham*, 383 U.S. at 17-18, 14 USPQ at 467.

The *KSR* Court rejected a rigid application of the “teaching, suggestion, or motivation [TSM]” test previously applied by the Court of Appeals for the Federal Circuit. *KSR*, 127 S.Ct. at 1739 USPQ2d at 1395. However, the Supreme Court affirmed that it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does...because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396. Once the *Graham* factors have been addressed, the Examiner may apply the TSM test, asking whether (1) a teaching, suggestion or motivation exists in the prior art to combine the references cited, and (2) one skilled in the art would have a reasonable expectation of success. See USPTO Guidelines at 57534.

Further, in order to establish *prima facie* obviousness of a claimed invention, all the

claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Additionally, in considering a prior art reference, the reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

Moreover, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). Indeed, “an applicant may rebut a *prima facie* case of obviousness by showing that the prior art teaches away from the claimed invention *in any material respect*.” *In re Peterson*, 315 F.3d 1325, 1331 (Fed. Cir. 2003). (Emphasis added.)

As a preliminary matter, note that claims 1, 2, 5, and 6 have been cancelled. The rejections of these claims are therefore moot and should be withdrawn.

Claim 3, as amended, recites:

3. A cable structure used for installing an optical fiber composite electric power cable, comprising:  
a conductor for electric power transmission;  
an insulator surrounding the conductor;  
an air-blown installation tube provided out of the insulator;  
a corrosion-protective layer provided to an outermost layer of the cable; and  
*tube protecting bodies contacting with both sides of the air-blown installation tube,*  
*wherein the tube protecting bodies are made of material having lower strength than the air-blown installation tube.*  
(Emphasis added.)

For the limitations of former claims 5 and 6, now incorporated into amended claim 3, the Examiner relied upon Quistorff, and in particular the “strength elements” disclosed in Quistorff as being “provided around the circumference of the central innerduct and interposed among the plurality of air blown fiber (ABF) tubes.” Quistorff, Abstract. However, these “strength elements” are apparently designed to increase the overall tensile strength of the cable structure, in contrast to the tube protecting bodies recited in claim 3. Consequently, Quistorff fails to teach, disclose, or suggest all the limitations of the tube protecting bodies recited in claim 3.

First, Quistorff fails to disclose, teach, or suggest that its “strength elements” must be in contact with *both sides* of the air-blown installation tube, as required by claim 3. Instead, Quistorff’s strength elements are merely “interposed among” his air blown fiber tubes. This is also clear from Fig. 2 of Quistorff, in which each air blown fiber tube is contacted on only one side by a “strength element.”

Secondly, the tube protecting bodies recited in claim 3 are required to be *made of material having lower strength than the air-blown installation tube*. No such disclosure, teaching, or suggestion is found in Quistorff. In fact, Quistorff’s consistent reference to these features as “strength” elements teaches away from the “lower strength” of the tube-protecting bodies recited in claim 3. As discussed in paragraph 33 of the US Publication of the present application, this relatively “lower strength” is required so that the tube protecting bodies do not damage the air-blown installation tubes that they are designed to protect. Thus, even if the other elements of claim 3 were found elsewhere, and even if one were motivated to combine these with the “strength elements” of Quistorff, one could not obtain the cable structure recited in claim 3, and in fact the resulting structure would not function properly because of the possibility that the “strength elements” could damage the air blown installation tubes.

Because the cited references, alone or in combination, fail to teach, disclose, or even suggest all the limitations of claim 3, claim 3 is not obvious in view of these references. The rejection of claim 3 should therefore be withdrawn. Because claims 4, 7, and 8 are dependent claims depending from claim 3, the rejections of these claims should also be withdrawn, for at least this reason.

***Conclusion***

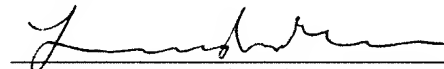
In view of the above, applicants respectfully submit that the present application is in condition for allowance. A favorable disposition to that effect is respectfully requested.

No fees are believed to be due with this submission. Please charge any fee that may be due or credit any overpayment to Jones Day Deposit Account No. 50-3013.

Should the Examiner have any questions or comments concerning this submission, he is invited to call the undersigned at the phone number listed below.

Date: January 30, 2009

Respectfully submitted,



Lawrence R. Gabuzda (Reg. No. 51,711)

**JONES DAY**

222 East 41st Street

New York, New York 10017

(212) 326-3939